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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,833	04/21/2000	Patrick Mark Curry	273012011100	6384

25225 7590 12/11/2002  
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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/556,833

Applicant(s)

CURRY ET AL.

Examiner

Stephen L. Rawlings, Ph.D.

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-16.Claim(s) withdrawn from consideration: 17-21.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See attached Note of Explanation

### NOTE OF EXPLANATION

1. The amendment filed October 15, 2002 (Paper No. 17) is acknowledged but will not be entered because the proposed amendment if entered, would raise new issues that would require further consideration and/or search, would raise the issue of new matter, and would not place the application in better form for appeal by materially reducing or simplifying the issues for appeal. If the proposed amendment were to have been entered, claim 1 would recite the intended use "for inhibiting growth" and the limitation "comprising a wavelength". In addition, claim 2 would recite the limitation "due to a primary tumor". Thus, entry of the amendment would necessitate further consideration to determine whether or not the specification provides proper antecedent basis for the recitations in the claims, as the claims would be amended. Furthermore, claim 15 would be amended to recite the limitation "which increases penetration"; therefore, apart from the necessitating further consideration to determine whether or not the specification provides proper antecedent basis for the recitation in the claim, the amendment would raise a new issue under 35 USC § 112, second paragraph, as the term "increases" is a relative term. Thus, the amendment would necessitate further consideration of the claim in light of the teachings of the specification.

2. In reply to Applicants' remarks, as noted in the previous Office action, although the hyperlink has been "inactivated", a reference to a hyperlink, or the website identified by such a hyperlink is not permissible for the reasons thoroughly stated in the previous Office action.

With regard to Applicants' grounds of traversal of the rejection of the claims under 35 USC § 103(a), the excerpt to which Applicants have referred is taken from the second Office action and not the text of the rejection. As stated in the rejection, given the benefit of the teachings of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted BPD-MA for the photosensitizer of US Patent No. 6,290,712-B1; and for the many reasons stated in the previous Office action, one of ordinary skill in the art would have been motivated

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to have done so, not the least of which would have been a reasonable expectation of success. Furthermore, the Office met the initial burden of establishing a prima facie case in the first Office action mailed November 6, 2001 (Paper No. 11). Otherwise, Applicants have reiterated arguments that were first advanced in reply to the first Office action in Paper No. 13; the merit of these arguments was addressed in the Office action mailed August 13, 2002 (Paper No. 16).


3. Claims 1-21 are pending in the application; claims 17-21 have been withdrawn; and claims 1-16 remain rejected under the grounds set forth or maintained in the previous Office Action. No claims are allowed.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Thursday, alternate Fridays, 8:00AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

  
COMMUNICATIONS SECTION  
DECEMBER 4, 2002

slr  
December 4, 2002